

Serial No.: 09/729,394
 Attorney Docket No.: F-223

Patent

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
 BOARD OF PATENT APPEALS AND INTERFERENCES**

In re patent application of:) Attorney Docket No.: F-223
) Customer No. 919
 Matthew S. Kissner, et al.)
)
 Serial No.: 09/729,394) Examiner: Firmin Backer
 Filed: December 4, 2000) Group Art Unit: 3621
 Confirmation No.: 6441)
) Date: October 21, 2003

Title: REMOTE POSTAGE RESETTING SYSTEM HAVING REBATE
 GENERATING CAPABILITIES

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APPELLANT'S BRIEF ON APPEAL

Sir:

This is an appeal pursuant to 35 U.S.C. § 134 and 37 C.F.R. §§ 1.191 et seq. from the final rejection of claims 1-10 and 12-18 of the above-identified application mailed May 21, 2003. Claims 1-10 and 12-18 stand at least twice rejected. This Brief is in furtherance of the Notice of Appeal filed in this case on August 21, 2003. This Brief is transmitted in triplicate. Accordingly, this brief is timely filed. The fee for submitting this Brief is \$330.00 (37 C.F.R. § 1.17(c)). Please charge Deposit Account No. 16-1885 in the amount of \$330.00 to cover these fees. The Commissioner is hereby authorized to charge any additional fees that may be required for this appeal or to make this brief timely or credit any overpayment to Deposit Account No. 16-1885. Enclosed with this original are two copies of this brief.

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, on October 21, 2003 (Date of Transmission).
 George M. Macdonald, Reg. No. 39,284 (Name of Registered Rep.)

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Date: October 21, 2003
Subject: Serial No.: 09/729,394
Pages: 15 (including this cover)

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Re: U.S. Patent Application Serial No.: 09/729,394
Our Docket # F-223

In furtherance of the August 21, 2003 Notice of Appeal in the above referenced case, enclosed please find the Appellants' Brief.

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1. Appellants' Brief on Appeal (14 pages).

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I. Real Party in Interest

The real party in interest in this appeal is Pitney Bowes Inc., a Delaware corporation, the assignee of this application.

II. Related Appeals and Interferences

There are no appeals or interferences known to Appellants, their legal representative, or the assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 1, 3, 4, 10, 14 and 15 are in the case and under final rejection of the Examiner rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,909,373 to Sansone, et al. ("Sansone '373").

Claims 2 and 13 are in the case and under final rejection of the Examiner rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious by U.S. Patent No. 5,909,373 to Sansone, et al.

Claims 5, 7, and 8 are in the case and under final rejection of the Examiner rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious by U.S. Patent No. 5,909,373 to Sansone, et al. in view of U.S. Patent No. 6,018,718 to Walker, et al. ("Walker '718"). While claims 9 and 12 are noted in the summary as rejected, they are not listed in the summary of this rejection. However, the Examiner discusses claims 9 and 12 along with the above claims under an alleged obviousness rejection.

Claim 6 is in the case and under final rejection of the Examiner rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious by U.S. Patent No. 5,907,830 to Engel, et al. ("Engel '830"). Appellants suspect that the Examiner is also applying U.S. Patent

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No. 5,909,373 to Sansone, et al. in view of U.S. Patent No. 6,018,718 to Walker, et al. to the claim.

Claim 16 is in the case and under final rejection of the Examiner rejected under 35 U.S.C. § 103(a) as allegedly rendered obvious by U.S. Patent No. 5,909,373 to Sansone, et al. in view of U.S. Patent No. 6,018,718 to Walker, et al. and U.S. Patent No. 5,907,830 to Engel, et al.

Claims 17 and 18 are in the case and under final rejection of the Examiner. The Examiner states that the claims disclose the same inventive concept as claims 1-16 and are rejected under the same rationale. Appellants are unsure as to which of the above five rationales are applied.

Appellants hereby appeal the rejection of claims 1-10 and 12-18.

IV. Status of Amendments

There are no amendments to the claims filed subsequently to the final rejection of May 21, 2003. Therefore, the claims set forth in Appendix A to this brief are those as set forth before the final rejection.

V. Summary of Invention

Appellants' invention relates to methods and systems for generating rebates in a remote postage meter resetting system to reward users based on the amount of use of the system thereby encouraging the use of the postage metering system instead of stamps. For example, the Applicants describe a data center for a postage meter resetting system that includes a computer that receives a postage refill request to electronically add a postage refill amount to a postage meter; structure for determining at the computer a rebate value associated with the postage refill request; and apparatus for sending the rebate value to a designated location.

Once the reset code has been sent, the computer 7 calculates a rebate amount that is due to the licensed meter user based on the refilling of postage meter 27 with

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additional funds. Typically, the rebate amount will be based on the actual amount of postage added to the postage meter 27. For example, the rebate amount may be any fixed percentage of the refill amount or a specific value associated with defined refill amount ranges. However, any method of computing or determining a rebate amount whether it is based on the refill amount, the number of refills, or other data associated with postage meter refill activity such as frequency and timeframes. (Specification at page 9, lines 3-13, emphasis added).

Upon generation of the rebate amount, the computer 7 initiates the process of providing the rebate to the postage meter 27 user via one of a plurality of methods. The specific manner in which computer 7 determines the which rebate return method to use is accomplished in one of two ways. Either postage meter 27 is provided with the functionality to permit the user to select (via keyboard 31) a desired rebate return method together with the refill request [...]. (Specification at page 9, lines 14-21, emphasis added, see for example claim 9).

Data center 5 includes a loyalty revenue database 79 that identifies for each licensed postage meter 27 all address, account, and other data that is needed by computer 7 to effectuate any selected rebate return method. The return method may include issuance of a check, funds transfer, a credit posted as a credit at a specified credit card company, and issuance of a certificate redeemable for goods and/or services. (Specification at page 9, line 21 – page 10, line 12, emphasis added).

The certificate can be sent electronically and the certificate that is generated at data center 5 can be cryptographically secured using conventional cryptographic techniques so that the certificate can be validated as being authentic by the vendor. (Specification at page 11, lines 9-22)

Additional features of the invention are discussed below in the Argument section of this Brief. This summary is not intended to supplant the description of the claimed subject matter as provided in the claims as recited in Appendix A, as understood in light of the entire specification.

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VI. Issues

Whether claims 1, 3, 4, 10, 14 and 15 are patentable under 35 U.S.C. §102(b);
Whether claims 2, 5-9, 12, 13 and 16 are patentable under 35 U.S.C. §103(a);
and
Whether claims 17 and 18 are properly rejected.

VII. Grouping of Claims

Claims 1-10 and 12-18 are grouped in the following groups:

Group I - Claims 1, 3, 4, 10, 14 and 15.

Group II - Claims 2, 5, 7, 8, 12, and 13.

Group III - Claim 9.

Group IV - Claims 6 and 16.

Group V - Claims 17 and 18.

In Group I, independent claim 1 and claims 3-4 that depend directly or indirectly from claim 1 stand or fall together. Independent claim 10 and claims 14-15 that depend directly or indirectly from claim 10 stand or fall together and with those of Group 1.

In Group II, claims 2, 5, and 7-8 that depend directly or indirectly from claim 1 stand or fall together. Similarly, claims 12-13 that depend directly or indirectly from claim 10 stand or fall together and with those of Group II.

In Group III, claim 9 that depends directly from claim 1 stands or falls alone.

In Group IV, claim 6 that depends indirectly from claim 1 and claim 16 that depends directly from claim 10 stand or fall together.

In Group V, independent claim 17 and dependent claim 18 stand or fall together.

VIII. Argument

As Appellants discuss in detail below, the final rejection of several of claims 1-10 and 11-18 is devoid of any factual or legal premise that supports the position of

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unpatentability. It is respectfully submitted that the rejection does not even meet the threshold burden of presenting a prima facie case of unpatentability. For this reason alone, Appellants are entitled to grant of a patent. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

A. Claims 1, 3, 4, 10, 14 and 15 Are Not Unpatentable Under 35 U.S.C. Section 102(a)

Claim 1 is directed to a method for generating a rebate in a postage meter and is shown below:

1. A method for generating a rebate in a postage meter resetting system, the method comprising the steps of: receiving a postage refill request at a postage data center to electronically add postage to a postage meter; determining at the postage data center a rebate value associated with the postage refill request; and sending the rebate value to a designated location, wherein the rebate value is based on the postage refill amount. (emphasis added).

In the May 21, 2003 Final Office Action, the Examiner rejected claims 1, 3, 4, 10, 14 and 15 under 35 U.S.C. section 102(b).

Applicant respectfully disagrees with the rejection and urges its reversal for at least the reasons stated below.

The Examiner states in the May 21, 2003 Final Office Action:

Applicants' means for determining a rebate reads on element 26 and elements 61 and 62 (figure 5) [of Sansone '373]. (Final Office Action, section 2).

The Examiner attempts to refute appellants' assertion that "a rebate based on the current postage refill amount" is not inherent. On page 5 of the Final Office Action, in a section entitled Response to Arguments, the Examiner purports to describe the cited reference. However, the Examiner does not recite any teaching or suggestion of the emphasized element "wherein the rebate value is based on the postage refill amount" in the reference cited.

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To establish anticipation of the claims under § 102(b), the Examiner is required to show that every element or step of the claim is found in a single reference. "To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter." PPG Indus., Inc. v. Guardian Indus. Corp., 75 F.3d 1558, 1566, 37 U.S.P.Q.2D (BNA) 1618, 1624 (Fed. Cir. 1996). To support an "inherency" argument, the Examiner must show that the reference necessarily includes the claimed limitation. See *In re Rijckaert*, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) (rejecting unsupported assertion of inherency).

Sansone '373 describes rebates based upon prior postage meter transactions. See for example, Col. 5, lines 14-27, Col. 3, lines 34-42.

The above specification describes a new and improved kiosk and data center. The kiosk contains a postage meter that is able to be refilled from a remote data center that receives information regarding the postage meters transactions so that discounts may be given to the owner of the kiosk. (Col. 5, lines 28-33).

Accordingly, the Examiner has failed to show that each element of the claim is anticipated. Accordingly, claim 1 is patentable over the cited reference. Claim 10 includes a similar element as shown above and is patentable over the cited reference for at least the same reason.

For at least the above stated reasons, Appellants respectfully submit that the final rejection as to claims 1, 3, 4 10, 14, and 15 is in error and should be reversed.

B. Claims 2, 5, 7-8 and 12 -13 Are Not Unpatentable Under 35 U.S.C. section 103(a)

Claims 2, 5, and 7-8 depend directly or indirectly from claim 1 and claims 12-13 depend directly or indirectly from claim 10.

In rejecting a claim under 35 U.S.C. §103, the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion. In *re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); in *re Lunsford*, 375 F.2d 385, 148 USPQ 721 (CCPA 1966); in *re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970).

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The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or combine applied references to arrive at the claimed invention. In re Ochiai, 37 USPQ2d 1127 (Fed. Cir. 1995); in re Deuel, 51 F.3d 1552, 34 USPQ 1210 (Fed. Cir. 1995); in re Fritch, 972 F.2d 1260, 23 USPQ 1780 (Fed. Cir. 1992); Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). In establishing the requisite motivation, it has been consistently held that both the suggestion and reasonable expectation of success must stem from the prior art itself, as a whole. In re Ochiai, supra; in re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); in re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); in re Dow Chemical Co., 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

As discussed above with reference to claims 1 and 10, the cited references do not teach or suggest each element of the invention as presently claimed.

For at least these reasons, Appellants respectfully submit that the final rejection as to claims 2, 5, 7-8 and 12-13 is in error and should be reversed.

C. Claim 9 is Not Unpatentable Under 35 U.S.C. section 103(a)

Claim 9 depends directly from claim 1 and is patentable for at least the reasons as described above with reference to claim 1.

Furthermore, claim 9 recites:

9. A method as recited in claim 1, further comprising receiving with the postage refill request a user preference for sending the rebate value, the preference being selected at the time of the postage refill request from one of issuing a check, electronically transferring funds, crediting an account, electronically transferring postage, and issuing a certificate. (emphasis added).

The Examiner has not provided any reference teaching or suggestion of the rebate preference element emphasized above.

For at least these reasons, Appellants respectfully submit that the final rejection as to claim 9 is in error and should be reversed.

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D. Claims 6 and 16 Are Not Unpatentable Under 35 U.S.C. section 103(a)

Claim 6 depends indirectly from claim 1 and claim 16 is directly dependent from claim 10. These claims are patentable for at least the reasons as described above with reference to claims 1 and 10.

Furthermore, claim 6 recites:

... cryptographically securing the certificate in order to
authenticate the source of the rebate... (emphasis added).

The Examiner has not provided any reference teaching or suggestion of the rebate preference element emphasized above.

For at least these reasons, Appellants respectfully submit that the final rejection as to claims 6 and 16 is in error and should be reversed.

E. Claims 17 and 18 Are Not Properly Rejected

Claim 17 is independent and claim 18 depends from claim 17. The Examiner states that the claims disclose the same inventive concept as claims 1-16 and are rejected under the same rationale. Appellants are unsure as to which of the above five rationales are applied. Accordingly, the rejection should be reversed.

Furthermore, claim 17 recites:

... receiving with the postage refill request a user preference for sending the rebate value, the preference being selected at the time of the postage refill request ...
(emphasis added).

The Examiner has not provided any reference teaching or suggestion of the rebate preference element emphasized above.

For at least these reasons, Appellants respectfully submit that the final rejection as to claims 17 and 18 is in error and should be reversed.

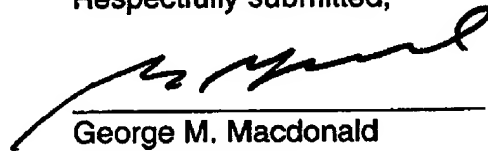
IX. Conclusion

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In Conclusion, Appellants respectfully submit that the final rejection of claims 1-10 and 12-18 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,



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APPENDIX A

1. A method for generating a rebate in a postage meter resetting system, the method comprising the steps of:

receiving a postage refill request at a postage data center to electronically add postage to a postage meter;

determining at the postage data center a rebate value associated with the postage refill request; and

sending the rebate value to a designated location,
wherein the rebate value is based on the postage refill amount.

2. A method as recited in claim 1, further comprising sending the rebate value in the form of a check.

3. A method as recited in claim 1, further comprising sending the rebate value as an electronic funds transfer to a designated account.

4. A method as recited in claim 1, further comprising sending the rebate value as a credit for posting at one of a credit card account and a postage line of credit database.

5. A method as recited in claim 1, further comprising sending the rebate value as a certificate that is redeemable upon presentment to a vendor.

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6. A method as recited in claim 5, further comprising cryptographically securing the certificate in order to authenticate the source of the rebate and verify that the certificate has not been modified.

7. A method as recited in claim 5, further comprising sending the certificate in electronic form to one of a facsimile, a postage meter, and an e-mail address.

8. A method as recited in claim 5, wherein the certificate is redeemable for one of money, services, supplies, discounts, and postage.

9. A method as recited in claim 1, further comprising receiving with the postage refill request a user preference for sending the rebate value, the preference being selected at the time of the postage refill request from one of issuing a check, electronically transferring funds, crediting an account, electronically transferring postage, and issuing a certificate.

10. A data center for a postage meter resetting system, the data center comprising:

a computer that receives a postage refill request to electronically add a postage refill amount to a postage meter;

means for determining at the computer a rebate value associated with the postage refill request; and

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means for sending the rebate value to a designated location, wherein the determining means determines the rebate value based on the postage refill amount.

12. A data center as recited in claim 11, wherein the determining means determines the rebate value as a percentage of the postage refill amount.

13. A data center as recited in claim 10, wherein the sending means includes means for issuing the rebate value in the form of a check.

14. A data center as recited in claim 10, wherein the sending means includes means for an electronic funds transfer of the rebate value to a designated account.

15. A data center as recited in claim 10, wherein the sending means includes means for sending the rebate value as a credit for posting at one of a credit card account and a postage line of credit database.

16. A data center as recited in claim 10, wherein the sending means includes means for sending the rebate value in the form of a cryptographically secured electronic certificate to at least one of a facsimile, a postage meter and an e-mail address.

17. A method for generating a rebate in a postage meter resetting system, the method comprising the steps of:

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receiving a postage refill request at a postage data center to electronically add postage to a postage meter;
determining at the postage data center a rebate value associated with the postage refill request; and
receiving with the postage refill request a user preference for sending the rebate value, the preference being selected at the time of the postage refill request from one of issuing a check, electronically transferring funds, crediting an account, electronically transferring postage, and issuing a certificate.

18. A method as recited in claim 17, further comprising:
sending the rebate value to a designated location as a certificate; and
cryptographically securing the certificate in order to authenticate the source of the rebate and verify that the certificate has not been modified.